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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

TRMB-T9824

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on March 5, 2008

Signature

Typed or printed
name

Mary Elias

Application Number

09/737,294

Filed

December 13, 2000

First Named Inventor

Rodric C. FAN

Art Unit

2617

Examiner

Naghmeh MEHRPOUR

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 35,398☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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03/05/08

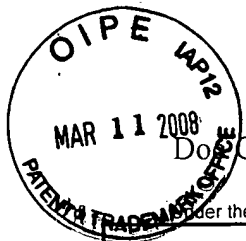
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
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REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

CLAIM REJECTIONS - 35 U.S.C. § 102(b)

According to the final rejection, Claims 1-4, 8-17, 20-22, 24-31 and 33-38 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bruce et al. (U.S. Publication No. 2005/0018822 A1; herein "Bruce"). Additionally, although the final rejection fails to explicitly declare a rejection of either of Claims 18 and 19 pursuant to 35 U.S.C. § 102(b), the final rejection seems to present an argument for rejecting these claims under 35 U.S.C. § 102(b).

MPEP § 2131 provides (emphasis added):

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

A. Claims 1 and 31

With respect to independent Claims 1 and 31, Applicants respectfully submit that Bruce fails to teach determining a location of a mobile unit by "receiving a telephone number of a wireline telephone ... located in a vicinity of said mobile unit, retrieving an address associated with said telephone number; and retrieving said location of said mobile unit based on said address", as recited in Claim 1 (emphasis added), and similarly in Claim 31.

Applicants understand Bruce to teach "triangulate the position of the caller though an analysis of RF signals" Bruce, page 4, paragraph [0038]. Applicants respectfully submit that triangulating the position of a caller by analyzing the RF signals of such caller to be very different than "receiving a telephone number of a wireline telephone ... located in a vicinity of said mobile unit, retrieving an address associated with said telephone number; and retrieving said location of said mobile unit based on said address", as claimed (emphasis added). Furthermore, Applicants respectfully note that a careful reading of Bruce did not identify any disclosures or teachings of such functionality.

The foregoing notwithstanding, the final rejection states that Bruce teaches “[i]f the geographical location of the caller can be determined by an automatic location identification system it is displayed on an operator console where the caller’s request is transferred to be handled by a live operator.” See page 15, paragraph 1, of the final rejection (emphasis added). Assuming arguendo that such an interpretation of Bruce is correct, Applicants nevertheless do not understand using an automatic location identification system to determine the geographical location of a caller to anticipate, either expressly or inherently, “receiving a telephone number of a wireline telephone ... located in a vicinity of said mobile unit, retrieving an address associated with said telephone number; and retrieving said location of said mobile unit based on said address”, as claimed (emphasis added).

Moreover, although page 2, section 1 of the final rejection cites the Public Switched Telephone Network (PSTN) disclosed on page 2, paragraph [0021] of Bruce, Applicants respectfully submit that the mere implementation of a PSTN does not anticipate, either expressly or inherently, “receiving a telephone number of a wireline telephone ... located in a vicinity of said mobile unit, retrieving an address associated with said telephone number; and retrieving said location of said mobile unit based on said address”, as claimed (emphasis added).

For at least the forgoing rationale, Applicants respectfully submit that there is nothing in Bruce to suggest that the claim features at issue are taught by Bruce, either expressly or inherently. Therefore, Applicants respectfully submit that essential elements needed for a *prima facie* rejection of Claims 1 and 31 pursuant to 35 U.S.C. § 102(b) are missing, and respectfully request review of the 35 U.S.C. § 102(b) rejections of these claims.

B. Claims 1, 18 and 31

The foregoing notwithstanding, with respect to independent Claims 1, 18 and 31, Applicants respectfully submit that Bruce fails to teach “receiving a telephone number of a wireline telephone through a data network, said wireline telephone being located in a vicinity of said mobile unit, and said telephone number being wirelessly transmitted to said data network by said mobile unit”, as recited in Claim 1 (emphasis added), and similarly in Claims 18 and 31.

As stated above, Applicants understand Bruce to teach “triangulate the

position of the caller though an analysis of RF signals” Bruce, page 4, paragraph [0038]. Applicants further understand Bruce to teach “[u]sing the location identified by the ALI, the operator can launch a database search for any such establishments in the proximity of the caller.” Bruce, page 4, paragraph [0041]. Thus, Applicants understand Bruce to teach that a caller transmits RF signals, which are then received and analyzed so as to triangulate the position of the caller, and a database may then be searched to identify establishments near the caller’s position.

Applicants respectfully submit that the teachings of Bruce are very different than the claim features at issue. In particular, Applicants understand Bruce to merely teach a mobile unit transmitting RF signals and an information request, which is very different than “receiving a telephone number of a wireline telephone through a data network, said wireline telephone being located in a vicinity of said mobile unit, and said telephone number being wirelessly transmitted to said data network by said mobile unit”, as claimed (emphasis added). Furthermore, Applicants respectfully note that a careful reading of Bruce did not identify any disclosures of such features. Thus, Applicants respectfully submit that there is nothing in Bruce to suggest that the claim features at issue are taught by Bruce, either expressly or inherently.

For at least the forgoing rationale, Applicants respectfully submit that there is nothing in Bruce to suggest that the claim features at issue are taught by Bruce, either expressly or inherently. Therefore, Applicants respectfully submit that essential elements needed for a *prima facie* rejection of Claims 1, 18 and 31 pursuant to 35 U.S.C. § 102(b) are missing, and respectfully request review of the 35 U.S.C. § 102(b) rejections of these claims.

With respect to Claims 2-4 and 8-17, Applicants respectfully point out that Claims 2-4 and 8-17 depend from independent Claim 1, and therefore recite the features of Claim 1. With respect to Claims 19-22 and 24-30, Applicants respectfully point out that Claims 19-22 and 24-30 depend from independent Claim 18, and therefore recite the features of Claim 18. With respect to Claims 33-38, Applicants respectfully point out that Claims 33-38 depend from independent Claim 31, and therefore recite the features of Claim 18. Thus, Applicants respectfully submit that essential elements needed for a *prima facie* rejection of Claims 2-4, 8-17, 19-22, 24-30 and 33-38 pursuant to 35 U.S.C. § 102(b) are missing, and respectfully request

review of the 35 U.S.C. § 102(b) rejections of these claims.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

A. Claims 5-7

According to the final rejection, Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruce in view of Obradovich (U.S. Publication No. 2002/0045456 A1), and Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruce in view of Kung et al. (U.S. Patent No. 6,680,935 B1; hereinafter "Kung").

Applicants respectfully submit that Bruce in view of Obradovich, and similarly Bruce in view of Kung, fails to teach or suggest the features of Claim 1, at least because Obradovich and Kung fail to overcome the shortcomings of Bruce, as discussed *supra*.

Applicants understand Obradovich to teach a GPS publication application server. Applicants understand Kung to teach anonymous call rejection in an Internet Protocol telephony network. However, Applicants do not understand the GPS publication application server of Obradovich, or the Internet Protocol telephony network of Kung, to teach or suggest "receiving a telephone number of a wireline telephone through a data network, said wireline telephone being located in a vicinity of said mobile unit, and said telephone number being wirelessly transmitted to said data network by said mobile unit; retrieving an address associated with said telephone number; and retrieving said location of said mobile unit based on said address", as claimed (emphasis added). Furthermore, Applicants respectfully note that a careful reading of both Obradovich and Kung did not identify any disclosures of such features.

Applicants respectfully submit that there is nothing in either Obradovich or Kung to suggest that the claim features at issue are taught by Obradovich or Kung, either expressly or inherently. Consequently, Applicants respectfully submit that Bruce, alone or in combination with Obradovich or Kung, fails to teach or suggest the features of Claim 1. In so much as dependent Claims 5-7 incorporate the features of Claim 1 by reference, Applicants respectfully submit that Bruce, alone or in combination with either Obradovich or Kung, fails to teach or suggest the embodiments of Claims 5-7.

In summary, Applicants respectfully submit that essential elements needed for a *prima facie* rejection of Claims 5-7 pursuant to 35 U.S.C. § 103(a) are missing, and respectfully request review of the 35 U.S.C. § 103(a) rejections of these claims.

B. Claim 23

According to the final rejection, Claim 23 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruce in view of Obradovich.

Applicants respectfully submit that Bruce in view of Obradovich fails to teach or suggest the features of Claim 18, at least because Obradovich fails to overcome the shortcomings of Bruce, as discussed *supra*.

Applicants understand Obradovich to teach a GPS publication application server. Applicants do not understand the GPS publication application server of Obradovich to teach or suggest "receiving a first telephone number through a data network, said first telephone number being associated with a first wireline telephone, and said first telephone number being wirelessly transmitted by said mobile unit to said data network", as recited in Claim 18 (emphasis added). Furthermore, Applicants respectfully note that a careful reading of Obradovich did not identify any disclosures of such features.

Applicants respectfully submit that there is nothing in Obradovich to suggest that the claim features at issue are taught by Obradovich, either expressly or inherently. Consequently, Applicants respectfully submit that Bruce, alone or in combination with Obradovich or Kung, fails to teach or suggest the features of Claim 18. In so much as dependent Claim 23 incorporates the features of Claim 18 by reference, Applicants respectfully submit that Bruce, alone or in combination with either Obradovich, fails to teach or suggest the embodiment of Claim 23.

In summary, Applicants respectfully submit that an essential element needed for a *prima facie* rejection of Claim 23 pursuant to 35 U.S.C. § 103(a) is missing, and respectfully request review of the 35 U.S.C. § 103(a) rejection of this claim.